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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,385

05/16/2005

Franz Grus

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7590

04/20/2006

WENDEROTH, LIND & PONACK, L.L.P.

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EXAMINER

FOSTER, CHRISTINE E

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/531,385

Applicant(s)

GRUS ET AL.

Examiner

Christine Foster

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, drawn to a method for the diagnosis of glaucoma.

Group II, claim(s) 19-21, drawn to a method of comparison of complex autoantibody patterns.

Group III, claim(s) 22, drawn to a method for assessing an individual's risk for developing glaucoma with or without an elevated intraocular pressure.

Group IV, claim(s) 23-26, drawn to a kit for the diagnosis of glaucoma.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

According to PCT Rule 13.2, unity of invention exists only when the shared same or corresponding technical feature is a contribution over the prior art. The inventions listed as Groups I-IV do not relate to a single general inventive concept because they lack the same or corresponding special technical feature. The technical feature of Group I is a method for the diagnosis of glaucoma, comprising the steps of detecting autoantibodies against ocular antigens in the body fluids of an individual and correlating the autoantibody pattern with corresponding patterns of healthy individuals and glaucoma patients

However, Wax et al., (Arch Ophthalmol Vol. 117, p. 917-924, 1999, cited in Applicant's Information Disclosure Statement of 4/15/05), teach detection of autoantibodies against ocular antigens (glycosaminoglycans of the optic nerve) in body fluids of an individual (serum) (see p. 917-918, in particular p. 918, the bottom paragraph which bridges the left and right columns). Wax et al. further teach correlating the autoantibody levels detected with those from control subjects and normal-pressure and open-angle glaucoma subjects (ibid and p. 920, the Table in the middle of the right column; and p. 921, right column, "Comment", the first paragraph; and the paragraph bridging pages 923-924).

Therefore, the technical feature linking the inventions of Groups I-IV does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

In addition, Groups I-IV each have technical features that are unrelated to the other groups. Group II includes the feature of comparing autoantibody patterns by calculation, which is not a limitation of the other Groups. Group III includes the feature of assessing risk for developing glaucoma with or without intraocular pressure, which is not a limitation of the other Groups. Group IV includes the limitation of a kit comprising a ready-to-use ocular antigen mixture, which is not a limitation of the other Groups.

Accordingly, Groups I-IV are not linked by the same or a corresponding special technical feature so as to form a single general inventive concept.

### ***Election of Species***

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3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

*a. Ocular antigens*

In the event that Group I is elected, the following species election must also be made (see claims 2-3):

- i. Retinal antigens
- ii. Optic nerve antigens
- iii. Optic nerve head antigens
- iv. Trabecular meshwork antigens
- v. Uveal antigens
- vi. A mixture of (i)-(v) above
- vii. A mixture of retinal antigens and optic nerve head antigens (see claim 3)

*b. Method of detection*

In the event that Group I is elected, the following species election must also be made:

- i. Western blot assay (see claims 10-11)
- ii. Chemiluminescence assay (see claim 10)
- iii. ELISA (see claim 10)
- iv. RIA (see claim 10)
- v. Mass spectrometry (see claims 12-15)
- vi. Electrophoretical techniques (see claim 15)

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In the event that Group IV is elected, the following species election must also be made:

- i. Western blotting (see claim 24)
- ii. SELDI-TOF (see claim 25)
- iii. Biochips (see claim 26)

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

Claims 1, 4-9, and 16-23 are generic. Claims 2-3, 10-15, and 24-26 are subject to species election.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

The species of **ocular antigens** are different because each group corresponds to a set of distinct proteins having different amino acid sequences, functions, and reactivities, and which are expressed in different locations. Moreover, the searches for one set of antigens is not necessarily coextensive with the searches of the other sets.

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The species of **methods of detection** are different because they involve distinct method steps and reagents, such that the searches are not coextensive. In the case of the kit of Group IV, the different methods of detection give rise to unique sets of reagents.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Notice of Possible Rejoinder***

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The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

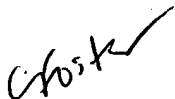


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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Foster whose telephone number is (571) 272-8786. The examiner can normally be reached on M-F 8:30-5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached at (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Art Unit 1641



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